

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA

SPY OPTIC, INC., a California corporation,
Plaintiff,
v.
WEST COAST DEALS, INC., a California corporation, dba WWW.HBSUNGLASSCOMPANY.COM; and
DOES 1 through 5, inclusive,
Defendants.
WEST COAST DEALS, INC., a California corporation, dba WWW.HBSUNGLASSCOMPANY.COM,
Counterclaimant,
v.
SPY OPTICS, INC., a California corporation, and ROES 1 through 5, inclusive,
Counterdefendants.

Civil No. 08CV0384 IEG(RBB)
CASE MANAGEMENT CONFERENCE
ORDER REGULATING DISCOVERY AND
OTHER PRETRIAL PROCEEDINGS
(Rule 16, Fed.R.Civ.P.)
(Local Rule 16.1)

Pursuant to Rule 16 of the Federal Rules of Civil Procedure,
the Court held a Case Management Conference on June 6, 2008. After

1 consulting with the attorneys of record for the parties and being
2 advised of the status of the case, and good cause appearing, IT IS
3 HEREBY ORDERED:

4 1. **Motions to Amend.** Any motion to join other parties, to
5 amend the pleadings, or to file additional pleadings shall be filed
6 on or before December 1, 2008.

7 2. **Disclosure of Asserted Claims and Preliminary**
8 **Infringement Contentions.** On or before July 28, 2008, Plaintiff
9 shall serve on all parties a "Disclosure of Asserted Claims and
10 Preliminary Infringement Contentions." Separately for each
11 opposing party, the "Disclosure of Asserted Claims and Preliminary
12 Infringement Contentions" must contain the following information:

13 a. Each claim of each patent in the suit that is
14 allegedly infringed by each opposing party;

15 b. Separately for each asserted claim, each accused
16 apparatus, product, device, process, method, act, or other
17 instrumentality ("Accused Instrumentality") of each opposing party
18 of which the party is aware. This identification must be as
19 specific as possible. Each product, device and apparatus must be
20 identified by name or model number, if known. Each method or
21 process must be identified by name, if known, or by any product,
22 device, or apparatus which, when used, allegedly results in the
23 practice of the claimed method or process;

24 c. A chart identifying specifically where each element
25 of each asserted claim is found within each Accused
26 Instrumentality, including for each element that the party contends
27 is governed by 35 U.S.C. § 112(6), the identity of the
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1 structure(s), act(s), or material(s) in the Accused Instrumentality
2 that performs the claimed function;

3 d. Whether each element of each asserted claim is
4 claimed to be literally present or present under the doctrine of
5 equivalents in the Accused Instrumentality;

6 e. For any patent that claims priority to an earlier
7 application, the priority date to which each asserted claim
8 allegedly is entitled; and

9 f. If a party claiming patent infringement asserts that
10 its own apparatus, product, device, process, method, act, or other
11 instrumentality practices the claimed invention, the party must
12 identify, separately for each asserted claim, each apparatus,
13 product, device, process, method, act, or other instrumentality
14 that incorporates or reflects that particular claim.

15 3. **Document Production Accompanying Disclosure.** With the
16 "Disclosure of Asserted Claims and Preliminary Infringement
17 Contentions," the party claiming patent infringement must produce
18 to each opposing party, or make available for inspection and
19 copying, the following documents in the possession, custody and/or
20 control of that party:

21 a. Documents (e.g., contracts, purchase orders,
22 invoices, advertisements, marketing materials, offer letters, beta
23 site testing agreements, and third party or joint development
24 agreements) sufficient to evidence each discussion with, disclosure
25 to, or other manner of providing to a third party, or sale of or
26 offer to sell, the claimed invention prior to the date of
27 application for the patent in suit. A party's production of a
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1 document as required herein does not constitute an admission that
2 the document evidences or is prior art under 35 U.S.C. §102;

3 b. All documents evidencing the conception, reduction
4 to practice, design, and development of each claimed invention,
5 which were created on or before the date of application for the
6 patent in suit or the priority date identified pursuant to P.L.R.
7 3.1(e), whichever is earlier; and

8 c. A copy of the file history for each patent in suit.
9 The producing party must separately identify by production
10 number which documents correspond to each category.

11 The party claiming patent infringement is required to use its
12 best efforts to obtain the documents to make a timely disclosure if
13 the documents identified above are not in the possession, custody
14 and/or control of that party.

15 4. **Preliminary Invalidity Contentions.** On or before
16 September 26, 2008, Defendant(s) shall serve on all parties
17 "Preliminary Invalidity Contentions," which must contain the
18 following information:

19 a. The identity of each item of prior art that
20 allegedly anticipates each asserted claim or renders it obvious.
21 Each prior art patent must be identified by its number, country of
22 origin, and date of issue. Each prior art publication must be
23 identified by its title, date of publication, and where feasible,
24 author and publisher. Prior art under 35 U.S.C. § 102(b) must be
25 identified by specifying the item offered for sale or publicly used
26 or known, the date the offer or use took place or the information
27 became known, and the identity of the person or entity which made
28 the use or which made and received the offer, or the person or

1 entity which made the information known or to whom it was made
2 known. Prior art under 35 U.S.C. § 102(f) must be identified by
3 providing the name of the person(s) from whom and the circumstances
4 under which the invention or any part of it was derived. Prior art
5 under 35 U.S.C. § 102(g) must be identified by providing the
6 identities of the person(s) or entities involved in and the
7 circumstances surrounding making the invention before the patent
8 applicant(s);

9 b. Whether each item of prior art anticipates each
10 asserted claim or renders it obvious. If a combination of items of
11 prior art makes a claim obvious, each combination and the
12 motivation to combine the items, must be identified;

13 c. A chart identifying where specifically in each
14 alleged item of prior art each element of each asserted claim is
15 found, including for each element that the party contends is
16 governed by 35 U.S.C. § 112(6), the identity of the structure(s),
17 act(s), or material(s) in each item of prior art that performs the
18 claimed function; and

19 d. Any grounds of invalidity based on indefiniteness
20 under 35 U.S.C. § 112(1) of any of the asserted claims.

21 5. **Document Production Accompanying Preliminary Invalidity**

22 **Contentions.** With the "Preliminary Invalidity Contentions," the
23 party opposing a claim of patent infringement must produce or make
24 available for inspection and copying:

25 a. Source code, specifications, schematics, flow
26 charts, artwork, formulas, or other documentation sufficient to
27 show the operation of any aspects or elements of any Accused
28 Instrumentality identified by the patent claimant in the

1 "Disclosure of Asserted Claims and Preliminary Infringement
2 Contentions;"

3 b. A copy of each item of prior art identified in the
4 Preliminary Invalidity Contentions, which does not appear in the
5 file history of the patent(s) at issue. To the extent any item is
6 not in English, an English translation of the portion(s) relied
7 upon must be produced.

8 6. **Exchange of Proposed Claim Constructions and Extrinsic**
9 **Evidence.**

10 a. On or before October 10, 2008, the parties shall
11 simultaneously exchange a preliminary proposed construction of each
12 claim term, phrase, or clause which the parties have identified for
13 claim construction purposes. Each "Preliminary Claim Construction"
14 will also, for each element which any party contends is governed by
15 35 U.S.C. § 112(6), identify the structure(s), act(s), or
16 material(s) corresponding to that element.

17 b. At the same time the parties exchange their
18 respective "Preliminary Claim Constructions," they must also
19 provide a preliminary identification of extrinsic evidence,
20 including without limitation, dictionary definitions, citations to
21 learned treatises and prior art, and testimony of percipient and
22 expert witnesses they contend support their respective claim
23 constructions. The parties must identify each item of extrinsic
24 evidence by production number or produce a copy of any item not
25 previously produced. With respect to any witness, percipient or
26 expert, the parties must also provide a brief description of the
27 substance of that witness' proposed testimony.

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1 c. On or before October 24, 2008, the parties shall
2 simultaneously exchange "Responsive Claim Constructions"
3 identifying whether the responding party agrees with the other
4 party's proposed construction, or identify an alternate
5 construction in the responding party's preliminary construction, or
6 set forth the responding party's alternate construction.

7 d. At the same time the parties exchange their
8 respective "Responsive Claim Constructions," they must also provide
9 a preliminary identification of extrinsic evidence, including
10 without limitation, dictionary definitions, citations to learned
11 treatises and prior art, and testimony of percipient and expert
12 witnesses they contend support any responsive claim constructions.
13 The parties must identify each item of extrinsic evidence by
14 production number or produce a copy of any item not previously
15 produced. With respect to any witness, percipient or expert, the
16 parties must also provide a brief description of the substance of
17 that witness' proposed testimony.

18 e. The parties must thereafter meet and confer for the
19 purposes of narrowing the issues and finalizing preparation of a
20 Joint Claim Construction Chart, Joint Claim Construction Worksheet
21 and Joint Hearing Statement.

22 7. **Joint Claim Construction Chart, Worksheet and Hearing**
23 **Statement.** On or before November 7, 2008, the parties shall
24 complete and file a Joint Claim Construction Chart, Joint Claim
25 Construction Worksheet and Joint Hearing Statement.

26 a. The Joint Claim Construction Chart must have a
27 column listing complete language of disputed claims with the
28 disputed terms in bold type and separate columns for each party's

1 proposed construction of each disputed term. Each party's proposed
2 construction of each disputed claim term, phrase, or clause, must
3 identify all references from the specification or prosecution
4 history that support that construction and an identification of any
5 extrinsic evidence known to the party on which it intends to rely
6 either to support its proposed construction of the claim or to
7 oppose any other party's proposed construction of the claim,
8 including, but not limited to, as permitted by law, dictionary
9 definitions, citations to learned treatises and prior art, and
10 testimony of percipient and expert witnesses.

11 b. The parties Joint Claim Construction Worksheet must
12 be in the format set forth in Appendix A and include any proposed
13 constructions to which the parties agree, as well as those in
14 dispute. The parties must jointly submit the Joint Claim
15 Construction Worksheet on computer disk in both Word and
16 Wordperfect format or in any other format the Court may direct.

17 c. The Joint Hearing Statement must include:

18 1. The anticipated length of time necessary for
19 the Claim Construction Hearing; and

20 2. Whether any party proposes to call one or more
21 witnesses, including experts, at the Claim Construction Hearing,
22 the identity of each witness, and for each expert, a summary of
23 each opinion to be offered in sufficient detail to permit a
24 meaningful deposition of that expert.

25 d. At the Court's discretion, within 5 calendar days of
26 the submission of the Joint Claim Construction Chart, Joint Claim
27 Construction Worksheet and Joint Hearing Statement, the Court will
28 schedule and hold a status conference with the parties, in person

1 or by telephone, to discuss the schedule, witnesses and any other
2 matters regarding the Claim Construction Hearing.

3 8. **Completion of Claim Construction Discovery.** The parties
4 shall complete all discovery, including any depositions of any
5 witnesses, including experts, the parties intend to use in the
6 Claim Construction Hearing by December 5, 2008. An expert witness
7 identified in a party's Joint Hearing Statement may be deposed on
8 claim construction issues. The identification of an expert in the
9 Joint Hearing Statement may be deemed good cause for a separate
10 deposition on all substantive issues.

11 9. **Claim Construction Briefs.**

12 a. On or before December 19, 2008, the parties shall
13 simultaneously file and serve opening briefs and any evidence
14 supporting their claim construction.

15 b. On or before January 9, 2009, the parties shall
16 simultaneously file and serve briefs responsive to the opposing
17 party's opening brief and any evidence directly rebutting the
18 supporting evidence contained in the opposing party's opening
19 brief.

20 10. **Claim Construction Hearing.** On January 30, 2009, at 9:00
21 a.m., subject to the convenience of the Court's calendar, the
22 Honorable Irma E. Gonzalez will conduct a Claim Construction
23 Hearing, to the extent the Court believe a hearing is necessary for
24 construction of the claims at issue.

25 11. **Final Contentions.** Each party's "Preliminary
26 Infringement Contentions" and "Preliminary Invalidity Contentions"
27 will be deemed to be that party's final contentions, except as set
28 forth below.

1 a. If a party claiming patent infringement believes in
2 good faith that the Court's Claim Construction Ruling so requires,
3 not later than 30 days after service by the Court of its Claim
4 Construction Ruling, that party may serve "Final Infringement
5 Contentions" without leave of Court that amend its "Preliminary
6 Infringement Contentions."

7 b. Not later than 50 days after service by the Court of
8 its Claim Construction Ruling, each party opposing a claim of
9 patent infringement may serve "Final Invalidity Contentions"
10 without leave of Court that amend its "Preliminary Invalidity
11 Contentions" if: i) a party claiming patent infringement has
12 served "Final Infringement Contentions," or ii) the party opposing
13 a claim of patent infringement believes in good faith that the
14 Court's Claim Construction Ruling so requires.

15 12. Amendment to Contentions. Amendment or modification of
16 the Preliminary or Final Infringement Contentions or the
17 Preliminary or Final Invalidity Contentions, other than as
18 expressly permitted in the section above, may be made only by order
19 of the Court, which will be entered only upon a showing of good
20 cause.

21 13. Expert Witnesses. On or before March 30, 2009, all
22 parties shall exchange a list of all expert witnesses expected to
23 be called at trial. The list shall include the name, address, and
24 phone number of the expert and a brief statement identifying the
25 subject areas as to which the expert is expected to testify. The
26 list shall also include the normal rates the expert charges for
27 deposition and trial testimony. On or before April 20, 2009, any
28 party may supplement its designation in response to any other

1 party's designation so long as that party has not previously
2 retained an expert to testify on that subject.

3 14. Each expert witness designated by a party shall prepare a
4 written report to be provided to all other parties no later than
5 May 18, 2009, containing the information required by Fed. R. Civ.
6 P. 26(a)(2)(A) and (B). A written report is not required from a
7 witness giving testimony as a percipient expert.

8 **Except as provided in paragraph 15, below, any party that**
9 **fails to make these disclosures shall not, absent substantial**
10 **justification, be permitted to use evidence or testimony not**
11 **disclosed at any hearing or at the time of trial. In addition, the**
12 **Court may impose sanctions as permitted by Fed. R. Civ. P. 37(c).**

13 15. Any party, through any expert designated, shall in
14 accordance with Fed. R. Civ. P. 26(a)(2)(C) and Fed. R. Civ. P.
15 26(e), supplement any of its expert reports regarding evidence
16 intended solely to contradict or rebut evidence on the same subject
17 matter identified in an expert report submitted by another party.
18 Supplemental reports are due on or before June 8, 2009.

19 16. All fact discovery shall be completed on or before May
20 11, 2009. All expert discovery shall be completed on or before
21 June 29, 2009.

22 "Completed" means that all discovery under Rules 30-36 of the
23 Federal Rules of Civil Procedure must be initiated a sufficient
24 period of time in advance of the cut-off date, so *that it may be*
25 *completed* by the cut-off date, taking into account the times for
26 service, notice, response, and any corresponding discovery motions,
27 as set forth in the Federal Rules of Civil Procedure. All disputes
28 concerning discovery shall be brought to the attention of the

1 Magistrate Judge no later than thirty (30) days following the date
2 upon which the event giving rise to the discovery dispute occurred.
3 Counsel shall meet and confer pursuant to the requirements of Fed.
4 R. Civ. P. 26 and Local Rule 26.1(a).

5 17. All motions, other than motions to amend or join parties,
6 or motions in limine, shall be filed on or before July 27, 2009.

7 Motions will not be heard or calendared unless counsel for the
8 moving party has obtained a motion hearing date from the law clerk
9 of the judge who will hear the motion. Be advised that the parties
10 must file their moving papers within three (3) days of receiving
11 the motion hearing date from the Court. Be further advised that
12 the period of time between the date you request a motion date and
13 the hearing date may be up to six weeks. Please plan accordingly.

14 For example, you may need to contact the judge's law clerk at least
15 six weeks in advance of the motion cut-off to calendar the motion.
16 Failure of counsel to timely request a motion date may result in
17 the motion not being heard. Motions will not be heard on the above
18 date unless you have obtained that date in advance from the judge's
19 law clerk.

20 Briefs or memoranda in support of or in opposition to any
21 pending motion shall not exceed twenty-five (25) pages in length
22 without permission of the judge or magistrate judge who will hear
23 the motion. No reply memorandum shall exceed ten (10) pages
24 without leave of the judge or magistrate judge who will hear the
25 motion.

26 18. Further settlement conferences shall be held at
27 appropriate intervals during the course of the litigation in the
28 chambers of Judge Ruben B. Brooks. A telephonic, attorneys-only

1 settlement conference shall be held on July 18, 2008, at 8:00 a.m.
2 Counsel for Plaintiff is to initiate the call. A mandatory
3 settlement conference date will be set at one of the scheduled
4 settlement conferences.

5 All parties, claims adjusters for insured Defendants and non-
6 lawyer representatives with complete authority to enter into a
7 binding settlement, as well as the principal attorneys responsible
8 for the litigation, must be present and legally and factually
9 prepared to discuss and resolve the case at the mandatory
10 settlement conference and at all settlement conferences. Retained
11 outside corporate counsel shall not appear on behalf of a
12 corporation as the party representative who has the authority to
13 negotiate and enter into a settlement. Failure to attend or obtain
14 proper excuse will be considered grounds for sanctions.

15 **Confidential written settlement statements for the mandatory**
16 **settlement conference shall be lodged directly in the chambers of**
17 **Judge Brooks no later than five court days before the mandatory**
18 **settlement conference.** The statements need not be filed with the
19 Clerk of the Court or served on opposing counsel. The statements
20 will not become part of the court file and will be returned at the
21 end of the conference upon request. Written statements may be
22 lodged with Judge Brooks either by mail or in person.

23 Any statement submitted should avoid arguing the case.
24 Instead, the statement should include a neutral factual statement
25 of the case, identify controlling legal issues, and concisely set
26 out issues of liability and damages, including any settlement
27 demands and offers to date and address special and general damages
28 where applicable.

1 If appropriate, the Court will consider the use of other
2 alternative dispute resolution techniques.

3 19. Counsel shall serve on each other and file with the
4 Clerk of the Court their memoranda of contentions of fact and law
5 in compliance with Local Rule 16.1(f)(2) on or before November 13,
6 2009. On or before this date, all parties or their counsel shall
7 also fully comply with the pretrial disclosure requirements of rule
8 26(a)(3) of the Federal Rules of Civil Procedure.

9 20. Counsel shall confer and take the action required by
10 Local Rule 16.1(f)(4) on or before November 17, 2009. A personal
11 meeting between an incarcerated Plaintiff, acting in pro per, and
12 defense counsel is not required.

13 At this meeting, counsel shall discuss and attempt to enter
14 into stipulations and agreements resulting in simplification of the
15 triable issues. Counsel shall exchange copies and/or display all
16 exhibits other than those to be used for impeachment, lists of
17 witnesses and their addresses including experts who will be called
18 to testify and written contentions of applicable facts and law.
19 The exhibits shall be prepared in accordance with Local Rule
20 16.1(f)(2)(c). Counsel shall cooperate in the preparation of the
21 proposed final pretrial conference order.

22 21. The proposed final pretrial conference order, including
23 objections to any party's Fed. R. Civ. P. 26(a)(3) pretrial
24 disclosures, shall be prepared, served and lodged with the Clerk of
25 the Court on or before November 20, 2009, and shall be in the form
26 prescribed in and in compliance with Local Rule 16.1(f)(6).
27 Counsel shall also bring a court copy of the pretrial order to the
28 pretrial conference.

1 22. The final pretrial conference shall be held before the
2 Honorable Irma E. Gonzalez on November 30, 2009, at 10:30 a.m..

3 23. The dates and times set forth herein will not be
4 modified except for good cause shown.

5 24. Plaintiff's(s') counsel shall serve a copy of this order
6 on all parties that enter this case hereafter.

7 IT IS SO ORDERED.

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9 DATED: June 6, 2008


Ruben B. Brooks, Magistrate Judge
United States District Court

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11 cc:
12 Judge Gonzalez
13 All Parties of Record
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